APPENDIX A — JUDGMENT OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DATED JANUARY 12, 2007 AND FILED JANUARY 16, 2007

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2006-1431

RICHARD W. BERGER and BRANT W. BERGER,

Plaintiffs-Appellants,

v.

ROSSIGNOL SKI COMPANY, INC.,

Defendant-Appellee.

JUDGMENT

ON APPEAL from the UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF CALIFORNIA

in CASE NO(S). 05-CV-02523

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

Per Curiam (MICHEL, *Chief Judge*, GAJARSA, and DYK, *Circuit Judges*):

AFFIRMED. *See* Fed. Cir. R. 36.

Appendix A

ENTERED BY ORDER OF
THE COURT

DATED: JAN 12 2007

s/ Jan Horbaly
Jan Horbaly
Clerk

APPENDIX B — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF CALIFORNIA DENYING MOTION TO VACATE AND DISMISSING COUNTERCLAIMS AS MOOT DATED JULY 16, 2006

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

No. C 05-2523 CRB

RICHARD W. BERGER and BRANT W. BERGER,

Plaintiffs,

v.

ROSSIGNOL SKI COMPANY, INC.,

Defendant.

ORDER DENYING MOTION TO VACATE AND DISMISSING COUNTERCLAIMS AS MOOT

By Memorandum and Order filed April 25, 2006, the Court granted defendant's motion for summary judgment of non-infringement and entered judgment against plaintiffs. Now pending before the Court is plaintiffs' motion to vacate the judgment pursuant to Federal Rule of Civil Procedure 60(b). After carefully considering the papers filed by the parties, the Court concludes that oral argument is unnecessary, *see* Local Rule 7-1(b), and DENIES plaintiffs' motion.

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Plaintiffs have not persuaded the Court that it committed "clear error" within the meaning of Rule 60(b)(6). *See Gagan v. Sharar*, 376 F.3d 987, 992 (9th Cir. 2004). First, the Court was not mistaken that plaintiffs had identified 5B, 17 *and* 4 as the lower attachment. Plaintiffs' infringement contentions describe "a lower attachment connectable to a board" as "5B, 4, 17 connectable to board 2." This disclosure cannot reasonably be read as 5B, or 17, or 4. And the disclosure of all three components as the "lower attachment" in claim 1 is consistent with the fact that disc 5B holds components 4 and 17 to the snowboard.

Moreover, prior to their motion to vacate, plaintiffs have never argued that their disclosures did not identify 5B, 4 and 17 together as the lower attachment in claim 1, or even that there was any ambiguity in their contentions. A court does not commit clear error by failing to consider an argument that the movant never made. *See Glavor v. Shearson Lehman Hutton, Inc.*, 879 F.Supp. 1028, 1033 (N.D. Cal. 1994) (citing *Backlund v. Barnhart*, 778 F.2d 1386, 1388 (9th Cir. 1985)); *see also Keenan v Allen*, 91 F.3d 1275, 1279 (9th Cir. 1996) (holding that it is not the district court's task "to scour the record in search of a genuine issue of triable fact;" courts "rely on the nonmoving party to identify with reasonable particularity the evidence that precludes summary judgment") (internal quotation marks and citation omitted). Indeed, far from arguing that their infringement contentions could be read as not including component 4 as part of the lower attachment, plaintiffs admitted that their "original claim chart erroneously stated that the rotatable base 4, or coupler base, is part of the lower attachment." Plaintiffs' Opposition to Motion for Summary Judgment at 11.

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Second, the Court did not commit clear error in finding that plaintiffs had not shown good cause for amending their contentions. Plaintiffs' assertion that their error was a "minor" mistake rather than a deliberate choice is belied by their conduct. If the disclosure was indeed a minor mistake, a mere typographical error as plaintiffs imply, they should have been aware of the mistake at the latest when defendants moved for summary judgment. Once aware of the mistake, they should have immediately moved for leave to amend their infringement contentions. They did not; instead, they filed a Rule 56(f) motion to continue the summary judgment motion claiming they needed discovery to defeat the motion. They made no mention whatsoever of any errors in their preliminary infringement contentions.

Their "minor mistake" argument is also *inconsistent* with the declaration of their counsel, Douglas Allen, submitted in support of their belated motion to amend their infringement contentions. He explains: "[f]ollowing a defense filing of a 'Motion for Summary Judgment', the plaintiffs' retention of additional experienced counsel in the area of patent litigation and further '. . . discovery, evaluation, investigation and/or research . . .', which included evaluation of the physical binding submitted to plaintiffs' counsel through a mutual exchange of the physical bindings between my office and the office of Mr. O'Meara, it became apparent that revision of the preliminary infringement contentions and disclosure of asserted claims needed to be submitted." Docket No. 52, Declaration of Douglas Allen, ¶ 4. This statement is an admission that plaintiffs did not realize their contentions were "in error" until after they conducted additional "discovery, evaluation, investigation and/or research;" in other words,

the description of the lower attachment as encompassing components, 5B, 4 and 17 was not a mistake, but rather a deliberate decision that they did not decide to change until after engaging in further inquiry.

Plaintiffs' attempt to explain their delay by stating that they believed they could amend without leave of court after claim construction is unreasonable and unpersuasive. The Patent Local Rules provide that a party may amend its preliminary infringement contentions without leave of court within 30 days of receiving the court's claim construction order *only if* the party believes in good faith that the claim construction ruling or the documents served with preliminary invalidity contentions require amendment. Patent Local Rule 3-6(a). Neither of those exceptions applies to the circumstances alleged by plaintiffs. The Rules are clear that absent those two exceptions a party must show good cause for amendment. Patent Local Rule 3-7.

Finally, that plaintiffs' counsel telephoned defense counsel after plaintiffs filed their Rule 56(f) motion (but before the Court ruled) to advise counsel that plaintiffs wanted to move to amend their preliminary infringement contentions does not make the Court's findings erroneous. The telephone call does not dispute that plaintiffs did not indicate that they wanted to amend their preliminary infringement contentions until after filing a Rule 56(f) motion that did not mention any purported mistake. Nor does it dispute that they did not file a motion to amend their contentions until after this Court denied their Rule 56(f) motion. Moreover, counsel's declaration as to the telephone call does not indicate that counsel advised defense counsel

that plaintiffs wanted to amend their contentions to correct a mistake with respect to the "lower attachment" limitation. *See* Plaintiffs' Motion to Vacate at 12.

Nor have plaintiffs persuaded the Court that the judgment should be vacated because of counsel's "excusable neglect." Fed. R. Civ. P. 60(b)(1). The determination of whether a party has shown excusable neglect is an equitable one, taking into account all the circumstances, including prejudice to the nonmoving party, the length of the delay and its potential impact on judicial proceedings, the reason for the delay, and whether the movant acted in good faith. *See Briones v. Riviera Hotel & Casino*, 116 F.3d 379, 381 (9th Cir. 1997) (citing *Pioneer Inv. Servs. Co. v. Brunswick Assoc. Ltd. Partnership*, 507 U.S. 380 (1993)). As the Court's findings in its April 25, 2006 Memorandum and Order and this Order demonstrate, all of these factors militate against a finding of excusable neglect. It bears repeating that plaintiffs' assertion of an "inadvertent" mistake is contradicted by the sequence of events as well as the declaration of their own counsel. At the time plaintiffs moved to amend, counsel declared that it did not become apparent that the contentions needed to be amended until after plaintiffs received defendants' motion for summary judgment *and* retained additional counsel *and* conducted further discovery, investigation and/or research, including evaluation of the physical binding. Allen Decl. ¶ 4. In other words, only after they realized their original theory of infringement would fail did they decide that they needed to amend their contentions. Such conduct is not excusable neglect.

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Plaintiffs' other arguments do not merit discussion. Plaintiffs' motion to vacate is DENIED As the Court held that defendant's device does not infringe as a matter of law, defendant's invalidity and equitable estoppel counterclaims are dismissed as MOOT.

IT IS SO ORDERED.

Dated: July 16, 2006

s/ Charles R. Breyer
CHARLES R. BREYER
UNITED STATES DISTRICT JUDGE

APPENDIX C — MEMORANDUM AND ORDER OF THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF CALIFORNIA DATED APRIL 25, 2006

IN THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF CALIFORNIA

No. C 05-02523 CRB

RICHARD W. BERGER and BRANT W. BERGER,

Plaintiffs,

v.

ROSSIGNOL SKI COMPANY, INC.,

Defendant.

MEMORANDUM AND ORDER

Plaintiffs Richard W. Berger and Brant W. Berger bring this suit for patent infringement against defendant Rossignol Ski Company. Plaintiffs' complaint alleges that certain snowboard bindings manufactured and sold by Rossignol Ski Company infringe plaintiffs' U.S. Patent Nos. 5,913,530 (Filed June 16, 1997) and 6,196,569 (Filed April 23, 1999).

Now before the Court is defendant's motion for summary judgment of unenforceability, noninfringement, and invalidity. Because plaintiff only asserts claims from the '530 in their preliminary infringement contentions, only the '530 is in issue. Also before the Court is plaintiffs' cross motion for summary judgment of infringement and plaintiffs' motion

for leave to amend plaintiffs' preliminary infringement contentions to correct alleged errors in infringement contentions for the '530 and to add infringement contentions for the '569.

The critical issue is whether plaintiffs have shown good cause for amending their infringement contentions. Because the Court concludes that plaintiffs have not, their motion to amend must be denied and defendant's motion for summary judgment of noninfringement of the '530 must be granted.

BACKGROUND

A. Pre-filing Background

Plaintiffs first contacted defendant regarding plaintiffs' invention in April 1998. At that time, plaintiffs advised defendant of plaintiffs' International PCT Publication No. WO 97/49464, and stated "the claimed subject matter of the PCT application presents an issue of potential infringement" with respect to a rotatable step-in binding that had recently been introduced by the "Rossignol Group," which included defendant. Plaintiffs sought a meeting with defendant to discuss a possible collaboration. Defendant responded that it did not infringe plaintiffs' patent rights and further that the claims of the PCT application could not be allowed by the United. States Patent and Trademark Office over prior art; nonetheless, defendant agreed to meet with plaintiffs.

Plaintiffs met with defendant in July 1998, and provided defendant with some samples for consideration. In October 1998, defendant wrote Richard Berger and indicated defendant would not use plaintiffs' designs.

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In March 1999, plaintiffs notified defendant that plaintiffs' pending patent application was allowed by the patent office and sought another meeting to discuss the situation. Defendant met with plaintiffs and, after reviewing plaintiffs' allowed claims, notified plaintiffs that defendant intended to continue with its own design.

Plaintiffs again wrote to defendant, alleging that defendant possibly infringes plaintiffs' patent and advising defendant to determine whether it needed a license. Defendant reiterated its belief that it did not infringe plaintiffs' patent and, along with sending plaintiffs a sample of its accused product, defendant provided a detailed explanation as to why defendant's accused product did not infringe plaintiffs' patent.

Plaintiffs did not contact defendant again until after they filed this lawsuit in June 2005.

B. Post-filing Background

This Court held a case management conference on November 18, 2005. In accordance with Patent Local Rules 3-1 and 3-2, plaintiffs' preliminary infringement contentions were due 10 days after the conference. Plaintiffs, however, failed to serve their contentions, even after defendant repeatedly asked them to do so. Only after defendant moved to dismiss for failure to prosecute this action, or in the alternative to compel production of plaintiffs' preliminary infringement contentions, did plaintiffs provide the contentions. These contentions were filed more than five weeks after they were due, and then they only contained

infringement contentions for one of the two patents in suit, and only accused defendant of literal infringement. As a result of plaintiffs' submission defendant withdrew its motion to dismiss.

Based on these infringement contentions, defendant filed its invalidity contentions in accordance with Patent Local Rule 3-3 on February 17, 2006. Four days later defendant filed its motion for summary judgment now before this Court. At plaintiffs' request, the original March 31 hearing date on the motion for summary judgment was continued to April 14.

Plaintiffs' new co-counsel of record, Mr. Slobodin, made an appearance as co-counsel on March 14, 2006. The next day plaintiffs moved to defer defendant's motion for summary judgment to allow more time for discovery. This Court issued an order on March 21, 2006 denying the motion to defer under Federal Rule of Civil Procedure Rule 56(f) because plaintiffs failed to demonstrate how the information they sought would preclude summary judgment and plaintiffs failed to demonstrate that they exercised due diligence in seeking discovery. In fact, plaintiffs had not sought to take any discovery in the four months following the case management conference.

After the Court denied plaintiffs' motion to defer, plaintiffs notified defendant that they wished to amend their preliminary infringement contentions. As defendant refused to consent to the proposed amendments, plaintiffs filed a motion to amend.

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DISCUSSION

Defendant moves for summary judgment of noninfringement of the '530 based on plaintiffs' preliminary infringement contentions. Plaintiffs do not seriously contest that their contentions establish noninfringement; instead, they now assert that the preliminary infringement contentions were in error and they seek leave to amend the contentions. Defendant opposes granting leave to amend, and argues that even under plaintiffs' revised infringement contentions summary judgment is required.

A. Amending Preliminary Infringement Contentions

Patent Local Rule 3-7 allows parties to amend their preliminary or final infringement contentions, "other than expressly permitted in Patent L.R. 3-6 . . . by order of the Court, which shall be entered only upon a showing of good cause." Patent L.R. 3-7. Patent Local Rule 3-6 permits parties to amend their preliminary infringement contentions within 30 days after service of the Court's Claim Construction Ruling if the party in good faith believes that the ruling requires amendment. Patent L.R. 3-6. Because plaintiffs seek to amend outside the context of a claim construction hearing they must show "good cause." *See* Patent L.R. 3-6, 3-7. A determination of whether good cause has been established is within the sound discretion of the trial court. *See MEMC Elec. Materials. Inc. v. Mitsubishi Materials Silicon Corp.*, 420 F.3d 1369, 1380 n.5 (Fed. Cir. 2005).

Although federal courts are generally lenient in allowing parties to amend pleadings, such is not the case with

amending preliminary infringement contentions. *See LG Electronics, Inc. v. O-Lily Computer, Inc.*, 211 F.R.D. 360, 367 (N.D. Cal. 2002). The patent rules are designed to avoid "vexatious shuffling of positions" that could occur if the parties are permitted to freely modify their infringement contentions at any point in the action. *JSR Corp. v. Tokyo Ohka Kogyo Co.*, 2001 U.S. Dist. LEXIS 24959 *18 (N.D. Cal. Sep. 13, 2001). In *LG Electronics* the court stated:

> The patent local rules were adopted by this district in order to give claim charts more "bite." The rules are designed to require parties to crystallize their theories of the case early in the litigation and to adhere to those theories once they have been disclosed. . . . Unlike the liberal policy for amending pleadings, the philosophy behind amending claim charts is decidedly conservative, and designed to prevent the "shifting sands" approach to claim construction.

Id. at 367 (quoting *Atmel Corp. v. Information Storage Devices, Inc.*, 1998 U.S. Dist. LEXIS 17564 (N.D. Cal. 1998)). Since *Atmel*, the Patent Local Rules have been amended to add Patent Local Rule 3-6, which permits amending infringement contentions after a claim construction ruling. Commenting on the addition of L.R. 3-6, the court in *LG Electronics* stated: "[a]lthough the Patent Local Rules have since been amended to make it somewhat easier to amend claim charts, the general philosophy behind the Patent Local Rules remains as stated in *Atmel*." *Id.* This Court agrees that the Patent Local Rule's "good cause" standard remains more conservative than the lenient standard for amending pleadings.

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Plaintiffs rely on the declaration of their counsel, Mr. Allen, to establish grounds for amendment. Mr. Allen declares: "I believe I made errors in the preliminary contentions. The infringement contentions were belated in their production due to having to obtain information from distant locations around this and other states, and in reviewing this information, I neglected to include any claims from the '5.30 Patent." Allen Declaration, Docket 52, ¶ 3. Mr. Allen also claims that he qualified his preliminary infringement contentions with the statement that they were "subject to revision by plaintiffs based on additional discovery, evaluation, investigation and/or research." *Id.* at ¶ 4. Finally, Mr. Allen states: "[f]ollowing a defense filing of a 'Motion for Summary Judgment', the plaintiffs' retention of additional experienced counsel in the area of patent litigation and further '. . . discovery, evaluation, investigation and/or research . . .', which included evaluation of the physical binding submitted to plaintiffs' counsel through a mutual exchange of the physical bindings between my office and the office of Mr. O'Meara, it became apparent that revision of the preliminary infringement contentions and disclosure of asserted claims needed to be submitted." *Id.*

Mr. Allen's declaration does not establish "good cause." First, plaintiffs offer no explanation as to why the "errors" were made in the first place, and, in particular, how they could have "mistakenly" omitted any contentions as to the '569. Mr. Allen's claim that the contentions were late because they had to obtain information "from distant locations around this and other states" does not explain the errors, and, in any event, also does not adequately explain the delay. Mr. Allen does not identify what information

plaintiffs needed to gather; nor does he explain how that information was used in the contentions. This omission is especially glaring given that plaintiffs first accused defendant of infringement more than seven years ago. And they filed this lawsuit in June 2005. Plaintiffs have had more than adequate time to develop their infringement contentions.

Second, plaintiffs' assertion that they "qualified" their contentions by stating that they were subject to revision is immaterial; a party cannot unilaterally amend the Patent Local Rules.

Third, plaintiffs did not diligently seek to amend their contentions. Plaintiffs should have become aware of the alleged errors, and in particular, the omission of any contentions as to the '569, when defendant served its preliminary invalidity contentions; yet, plaintiffs did not notify defendant or the Court of any alleged errors at that time. Even if plaintiffs only became aware of the alleged errors after defendant filed its summary judgment motion, plaintiffs still did not notify the Court or defendant of any errors; instead, plaintiffs sought leave to amend their contentions only after unsuccessfully moving the Court to continue the summary judgment motion on the ground that they needed to take discovery. Their Rule 56(f) motion made no mention of any alleged errors. This sequence of events suggests that the motion to amend is a last-ditch effort to stave off summary judgment rather than a motion based on an honest mistake.

Fourth, the addition of co-counsel is not good cause. To hold otherwise would mean that a party could avoid the Local

Rules simply by adding a lawyer to the pleadings. Moreover, plaintiffs offer no explanation for why co-counsel was not brought into the case earlier, especially since plaintiffs admit that they were conferring with Mr. Slobodin as early as November 2004.

Finally, defendant would be prejudiced if the Court were to grant plaintiffs' motion for leave to amend. Defendant has relied on plaintiffs' preliminary infringement contentions for the past three months. Based on these contentions, defendant incurred substantial costs in creating its preliminary invalidity contentions and the costs associated with preparing their motion for summary judgment. Moreover, permitting amendment will further delay resolution of this case, which has already been delayed due to plaintiffs' unwillingness to comply with the Local Rules.

Plaintiffs' reliance on *ZiLog, Inc. v. Quicklogic Corp.*, 2006 U.S. DIST. Lexis 12844 (N.D. Cal. March 6, 2006) is misplaced. In *ZiLog*, the district court granted a motion to amend preliminary infringement contentions under the "good cause" standard where "effectively" three months had passed since plaintiffs had served the preliminary infringement contentions: *Id.* at *2 In fact, eight days after the preliminary infringement contentions were served the action was stayed. *Id.* Over the next year and a half, the patent office reexamined and invalidated several claims in the suit and the plaintiff had appealed the patent office's decision to the Board of Patent Appeals and Interference, which was still pending at the time of the motion to amend. *Id.* Plaintiff moved to lift the stay and *at the same time* provided notice in the parties' Joint Case Management Statement that it sought to amend

its preliminary infringement contentions. *Id.* Referencing its prior notice, plaintiff filed their motion to amend two months later. *Id.* Defendant had not filed a summary judgment motion or even filed preliminary invalidity contentions at the time of the motion to amend. *See id.* Thus, because the action was stayed during part of the delay, because plaintiff provided timely notice to defendant in relation to the timing of the motion to lift the stay, because plaintiff sought to amend based not on its own error but on the result of PTO reexamination, and because the defendants would not be prejudiced, the court granted leave to amend.

Unlike in *ZiLog*, plaintiffs here failed to promptly amend their preliminary infringement contentions. Waiting one month after defendant filed its motion for summary judgment, on top of the two months since serving their infringement contentions, on top of filing the preliminary infringement contentions more than five weeks late, does not amount to promptly seeking to amend. Further, unlike *ZiLog*, plaintiffs fail to assert any of the common factors that reasonably contribute to a finding of "good cause." Plaintiffs fail to provide any explanation for the original error or why it took nearly three months to discover and seek to correct the error. This delay suggests that the omission of any contentions as to the `569 and the contentions as to the '530 were not "errors," but were instead a deliberate strategic course which plaintiffs now wish to change.

In any event, giving plaintiffs the benefit of the doubt, the most they have established is that their counsel (who is still counsel of record) mishandled this case. Carelessness or mere errors, however, are insufficient to establish good

cause. *See Johnson v. Mammoth Recreations*, 975 F.2d 604, 609 (9th Cir. 1992)(holding that carelessness does not amount to "good cause" in the context of Federal Rule of Civil Procedure Rule 16(b)).

Because plaintiffs have failed to establish "good cause" to amend their preliminary infringement contentions, plaintiffs' motion for leave to amend must be denied. Even if plaintiffs were found to have promptly sought leave to amend they still fail to satisfy this district's good cause standard as they have not provided any justification for the amendment, other than mere error. In fact, plaintiffs offer so little explanation that to permit amendment here would render the "good cause" requirement meaningless.

B. Noninfringement

Having denied plaintiffs' motion to amend their preliminary infringement contentions the Court turns to the issue of literal infringement.

To determine infringement, the asserted claim must be compared to the allegedly infringing device. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995). For a device to literally infringe a patent, every claim limitation, or claim element, must be found in the device. *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 29, 40 (1997). Thus, establishing that the accused device does not satisfy one claim limitation requires a finding of noninfringement. *Id.*; *see also Mas-Hamilton Group v. La Gard, Inc.*, 156 F.3d 1206, 1211 (Fed. Cir. 1998) ("If even one limitation is missing or not met as claimed, there is no literal infringement.").

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Claim 1 of the '530 provides:

1. A binding, comprising:

a boot comprising an upper attachment,

a lower attachment connectable to a board,

a coupler attached to one of said upper and lower attachments, and

a coupling mount attached to the other of said upper attachments, the coupling mount and the coupler being configured to automatically engage with each other to lock the upper attachment to the lower attachment when a user wearing the boot steps onto the lower attachment and to permit *rotation of the upper attachment relative to the lower attachment* when the upper attachment is locked to the lower attachment without release of said upper attachment from said lower attachment.

Claim 1 requires, among other things, "rotation of the upper attachment relative to the lower attachment." '530 Patent, col. 10:31-32. Plaintiffs' original infringement contentions and supporting illustrations label "plate 3" as the "upper attachment" satisfying the "a boot comprising an upper attachment" limitation of clam 1 of the '530 Patent. Plaintiffs label "5B, 4, 17 connectable to board 2" as the "lower attachment" satisfying the "a lower attachment connectable to the board" claim limitation, although plaintiffs' illustrations accompanying their infringement

contentions do not identify anything on the accused device as "17." In any event, it is undisputed that plate 3—the upper attachment—does not rotate *relative* to what plaintiffs' identify as the lower attachment; rather, the upper attachment rotates *with* the lower attachment. Accordingly, under plaintiffs' infringement contentions defendant's accused device does not read on at least one limitation of claim 1 of the `530 and therefore does not infringe as a matter of law. Further, because all asserted claims other than claim 1 are dependent claims of claim 1, the accused device infringes no other claims of the `530 Patent.

Plaintiffs all but admit noninfringement based on their original infringement contentions. Plaintiffs state:

> Defendant's noninfringement argument that accused binding is "missing the 'rotation of the upper attachment relative to the lower attachment' limitation," . . . is based on an error in Plaintiff[s'] preliminary claim chart. In that regard, Plaintiff[s'] original claim chart erroneously stated that the rotatable base 4, or coupler base, is part of the lower attachment. Plaintiffs' referring to the rotatable base, or coupler base, as part of the lower attachment was an error. The rotatable base, our coupler base, is not part of the lower attachment. Under the correct infringement contention, where the coupler base is not part of the lower attachment, the "rotation [o]f the upper attachment relative to the lower attachment limitation" is fulfilled.

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Plaintiffs' Opposition to Motion for Summary judgment, 11. Plaintiffs make no other representation regarding infringement based upon the original infringement contentions; indeed, at oral argument they merely asserted that their original infringement contention is "absurd." As the Court has ruled above, however, plaintiffs have not demonstrated good cause for amending their contentions.

Because it is undisputed that defendant's device does not read on at least one limitation of claim 1 of the '530, defendant's motion for summary judgment of noninfringement of the '530 must be granted and plaintiffs' motion for summary judgment of infringement of the ''530 must be denied.

CONCLUSION

The Patent Local Rules are designed to prevent exactly what plaintiffs are attempting to do here: alter their infringement theory after it became apparent that they were going to lose. As plaintiffs have not shown good cause for amending their preliminary infringement contentions, their motion to amend those contentions is DENIED and defendant's motion for summary judgment of noninfringement of the '530 is GRANTED. Because the Court concludes that defendant's device does not infringe as a matter of law, the Court need not and does not address defendant's claim of invalidity. *See Boss Control, Inc. v. Bombardier Inc.*, 410 F.3d 1372, 1374 (Fed. Cir. 2005). The Court also need not and does not address defendant's equitable estoppel argument. As the '530 is the only patent now at issue in this lawsuit, judgment will be entered in favor of defendant.

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IT IS SO ORDERED.

Dated: April 25, 2006 s/ Charles R. Breyer
CHARLES R. BREYER
UNITED STATES DISTRICT JUDGE

APPENDIX D — RULES INVOLVED

PATENT LOCAL RULES

3. PATENT INITIAL DISCLOSURES

3-1. Disclosure of Asserted Claims and Preliminary Infringement Contentions.

Not later than 10 days after the Initial Case Management Conference, a party claiming patent infringement must serve on all parties a "Disclosure of Asserted Claims and Preliminary Infringement Contentions." Separately for each opposing party, the "Disclosure of Asserted Claims and Preliminary Infringement Contentions" shall contain the following information:

(a) Each claim of each patent in suit that is allegedly infringed by each opposing party;

(b) Separately for each asserted claim, each accused apparatus, product, device, process, method, act, or other instrumentality ("Accused Instrumentality") of each opposing party of which the party is aware. This identification shall be as specific as possible. Each product, device, and apparatus must be identified by name or model number, if known. Each method or process must be identified by name, if known, or by any product, device, or apparatus which, when used, allegedly results in the practice of the claimed method or process;

(c) A chart identifying specifically where each element of each asserted claim is found within each Accused

Instrumentality, including for each element that such party contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function;

(d) Whether each element of each asserted claim is claimed to be literally present or present under the doctrine of equivalents in the Accused Instrumentality;

(e) For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled; and

(f) If a party claiming patent infringement wishes to preserve the right to rely, for any purpose, on the assertion that its own apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention, the party must identify, separately for each asserted claim, each such apparatus, product, device, process, method, act, or other instrumentality that incorporates or reflects that particular claim.

3-6. Final Contentions.

Each party's "Preliminary Infringement Contentions" and "Preliminary Invalidity Contentions" shall be deemed to be that party's final contentions, except as set forth below.

(a) If a party claiming patent infringement believes in good faith that (1) the Court's Claim Construction Ruling or (2) the documents produced pursuant to Patent L.R. 3-4 so requires, not later than 30 days after service by the Court of

its Claim Construction Ruling, that party may serve "Final Infringement Contentions" without leave of court that amend its "Preliminary Infringement Contentions" with respect to the information required by Patent L.R. 3-1(c) and (d).

(b) Not later than 50 days after service by the Court of its Claim Construction Ruling, each party opposing a claim of patent infringement may serve "Final Invalidity Contentions" without leave of court that amend its "Preliminary Invalidity Contentions" with respect to the information required by Patent L.R. 3-3 if:

(1) a party claiming patent infringement has served "Final Infringement Contentions" pursuant to Patent L.R. 3-6(a), or

(2) the party opposing a claim of patent infringement believes in good faith that the Court's Claim Construction Ruling so requires.

3-7. Amendment to Contentions.

Amendment or modification of the Preliminary or Final Infringement Contentions or the Preliminary or Final Invalidity Contentions, other than as expressly permitted in Patent L.R. 3-6, may be made only by order of the Court, which shall be entered only upon a showing of good cause.

Appendix D

Rule 83. Rules by District Courts; Judge's Directives

(a) Local Rules.

(1) Each district court, acting by a majority of its district judges, may, after giving appropriate public notice and an opportunity for comment, make and amend rules governing its practice. A local rule shall be consistent with — but not duplicative of — Acts of Congress and rules adopted under 28 U.S.C. §§ 2072 and 2075, and shall conform to any uniform numbering system prescribed by the Judicial Conference of the United States. A local rule takes effect on the date specified by the district court and remains in effect unless amended by the court or abrogated by the judicial council of the circuit. Copies of rules and amendments shall, upon their promulgation, be furnished to the judicial council and the Administrative Office of the United States Courts and be made available to the public.

(2) A local rule imposing a requirement of form shall not be enforced in a manner that causes a party to lose rights because of a nonwillful failure to comply with the requirement.

(b) Procedures When There is Not Controlling Law. A judge may regulate practice in any manner consistent with federal law, rules adopted under 28 U.S.C. §§ 2072 and 2075, and local rules of the district. No sanction or other disadvantage may be imposed for noncompliance with any requirement not in federal law, federal rules, or the local district rules unless the alleged violator has been furnished in the particular case with actual notice of the requirement.

Appendix D

FEDERAL RULES OF CIVIL PROCEDURE

Rule 8. General Rules of Pleading

(a) Claims for Relief. A pleading which sets forth a claim for relief, whether an original claim, counterclaim, cross-claim, or third-party claim, shall contain (1) a short and plain statement of the grounds upon which the court's jurisdiction depends, unless the court already has jurisdiction and the claim needs no new grounds of jurisdiction to support it, (2) a short and plain statement of the claim showing that the pleader is entitled to relief, and (3) a demand for judgment for the relief the pleader seeks. Relief in the alternative or of several different types may be demanded.

(b) Defenses; Form of Denials. A party shall state in short and plain terms the party's defenses to each claim asserted and shall admit or deny the averments upon which the adverse party relies. If a party is without knowledge or information sufficient to form a belief as to the truth of an averment, the party shall so state and this has the effect of a denial. Denials shall fairly meet the substance of the averments denied. When a pleader intends in good faith to deny only a part or a qualification of an averment, the pleader shall specify so much of it as is true and material and shall deny only the remainder. Unless the pleader intends in good faith to controvert all the averments of the preceding pleading, the pleader may make denials as specific denials of designated averments or paragraphs or may generally deny all the averments except such designated averments or paragraphs as the pleader expressly admits; but, when the pleader does so intend to controvert all its averments, including averments

of the grounds upon which the court's jurisdiction depends, the pleader may do so by general denial subject to the obligations set forth in Rule 11.

(c) Affirmative Defenses. In pleading to a preceding pleading, a party shall set forth affirmatively accord and satisfaction, arbitration and award, assumption of risk, contributory negligence, discharge in bankruptcy, duress, estoppel, failure of consideration, fraud, illegality, injury by fellow servant, laches, license, payment, release, res judicata, statute of frauds, statute of limitations, waiver, and any other matter constituting an avoidance or affirmative defense. When a party has mistakenly designated a defense as a counterclaim or a counterclaim as a defense, the court on terms, if justice so requires, shall treat the pleading as if there had been a proper designation.

(d) Effect of Failure to Deny. Averments in a pleading to which a responsive pleading is required, other than those as to the amount of damage, are admitted when not denied in the responsive pleading. Averments in a pleading to which no responsive pleading is required or permitted shall be taken as denied or avoided.

(e) Pleading to be Concise and Direct; Consistency.

(1) Each averment of a pleading shall be simple, concise, and direct. No technical forms of pleading or motions are required.

(2) A party may set forth two or more statements of a claim or defense alternately or hypothetically, either in one count

or defense or in separate counts or defenses. When two or more statements are made in the alternative and one of them if made independently would be sufficient, the pleading is not made insufficient by the insufficiency of one or more of the alternative statements. A party may also state as many separate claims or defenses as the party has regardless of consistency and whether based on legal, equitable, or maritime grounds. All statements shall be made subject to the obligations set forth in Rule 11.

(f) Construction of Pleadings. All pleadings shall be so construed as to do substantial justice.

Rule 15. Amended and Supplemental Pleadings

(a) Amendments. A party may amend the party's pleading once as a matter of course at any time before a responsive pleading is served or, if the pleading is one to which no responsive pleading is permitted and the action has not been placed upon the trial calendar, the party may so amend it at any time within 20 days after it is served. Otherwise a party may amend the party's pleading only by leave of court or by written consent of the adverse party; and leave shall be freely given when justice so requires. A party shall plead in response to an amended pleading within the time remaining for response to the original pleading or within 10 days after service of the amended pleading, whichever period may be the longer, unless the court otherwise orders.

(b) Amendments to Conform to the Evidence. When issues not raised by the pleadings are tried by express or implied consent of the parties, they shall be treated in all

respects as if they had been raised in the pleadings. Such amendment of the pleadings as may be necessary to cause them to conform to the evidence and to raise these issues may be made upon motion of any party at any time, even after judgment; but failure so to amend does not affect the result of the trial of these issues. If evidence is objected to at the trial on the ground that it is not within the issues made by the pleadings, the court may allow the pleadings to be amended and shall do so freely when the presentation of the merits of the action will be subserved thereby and the objecting party fails to satisfy the court that the admission of such evidence would prejudice the party in maintaining the party's action or defense upon the merits. The court may grant a continuance to enable the objecting party to meet such evidence.

(c) Relation Back of Amendments. An amendment of a pleading relates back to the date of the original pleading when

(1) relation back is permitted by the law that provides the statute of limitations applicable to the action, or

(2) the claim or defense asserted in the amended pleading arose out of the conduct, transaction, or occurrence set forth or attempted to be set forth in the original pleading, or

(3) the amendment changes the party or the naming of the party against whom a claim is asserted if the foregoing provision (2) is satisfied and, within the period provided by Rule 4(m) for service of the summons and complaint, the party to be brought in by amendment (A) has received such notice of the institution of the action that the party will not

be prejudiced in maintaining a defense on the merits, and (B) knew or should have known that, but for a mistake concerning the identity of the proper party, the action would have been brought against the party.

The delivery or mailing of process to the United States Attorney, or United States Attorney's designee, or the Attorney General of the United States, or an agency or officer who would have been a proper defendant if named, satisfies the requirement of subparagraphs (A) and (B) of this paragraph (3) with respect to the United States or any agency or officer thereof to be brought into the action as a defendant.

(d) Supplemental Pleadings. Upon motion of a party the court may, upon reasonable notice and upon such terms as are just, permit the party to serve a supplemental pleading setting forth transactions or occurrences or events which have happened since the date of the pleading sought to be supplemented. Permission may be granted even though the original pleading is defective in its statement of a claim for relief or defense. If the court deems it advisable that the adverse party plead to the supplemental pleading, it shall so order, specifying the time therefor.

Rule 83. Rules by District Courts; Judge's Directives

(a) Local Rules

(1) Each district court, acting by a majority of its district judges, may, after giving appropriate public notice and an opportunity for comment, make and amend rules governing its practice. A local rule shall be consistent with—but not

duplicative of—Acts of Congress and rules adopted under 28 U.S.C. §§ 2072 and 2075, and shall conform to any uniform numbering system prescribed by the Judicial Conference of the United States. A local rule takes effect on the date specified by the district court and remains in effect unless amended by the court or abrogated by the judicial council of the circuit. Copies of rules and amendments shall, upon their promulgation, be furnished to the judicial council and the Administrative Office of the United States Courts and be made available to the public.

(2) A local rule imposing a requirement of form shall not be enforced in a manner that causes a party to lose rights because of a nonwillful failure to comply with the requirement.

(b) Procedures When There is No Controlling Law. A judge may regulate practice in any manner consistent with federal law, rules adopted under 28 U.S.C. §§ 2072 and 2075, and local rules of the district. No sanction or other disadvantage may be imposed for noncompliance with any requirement not in federal law, federal rules, or the local district rules unless the alleged violator has been furnished in the particular case with actual notice of the requirement.